

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT Application of
Bern

Group Art Unit: 3709

U.S. App'n Ser. No.: 10/520,111

Examiner: Wert, Joshua P.

Filed: December 17, 2004

Att. Docket No.: 62642-P10008

For: A GAME CONSOLE IN AN ELECTRONIC CARD GAME SYSTEM, AN
ELECTRONIC GAME CARD TO BE RECEIVED THEREBY, AND AN
ELECTRONIC CARD GAME SYSTEM

*

*

*

*

*

28 January 2008

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is timely filed within two months of the 31 December 2007 mailing date of the Examiner's Answer. Appellants respond to each new argument raised by the Examiner in his Answer.

Claim 26 is Separately Patentable

On page 7 of the Examiner's Answer, the Examiner argues that:

Appellant's arguments with respect to claim 26 are not found to be persuasive. While claim 26 differs from the previous claims discussed above in that it does claim at least 2 game cartridges, it still does not claim a cartridge in each of the game consoles. Merely what is claimed is a system as discussed above with an additional cartridge that can be swapped with the first. Sawano discloses the cartridge being removable as is claimed in claim 26. While Sawano does not explicitly disclose the presence of multiple game cartridges, it is inherent in the disclosure that if you have a removable game cartridge, the only purpose for it being removable is so that a user can place different cartridges in the system. If this were not the case, then it would be pointless to have a removable

cartridge. Sawano discloses a system with a removable game cartridge that meets the claim limitations of claim 26. Since the removable game cartridge disclosed is a general game cartridge and not a specific game cartridge for say a particular pin ball game, it is interpreted that general game cartridge is a representation of a large set of game cartridges usable by the system.

The Examiner correctly states that claim 26 requires at least two cartridges. However, claim 26 also recites at least two game consoles and the following steps:

- the processor being configured for, reading a first data item from an electronic game card at least partially inserted in the electronic game card receiving means,
- using the electronic game card reading means, receiving a second data item from a second game console using the communication means,
- the data comprising at least one game related attribute and at least one value associated thereto,
- generating a game result based on the first data item and the second data item in respect of the at least one game related attribute and the at least one value associated thereto,
- writing at least one first new value related to the at least one game related attribute to the memory of the electronic game card,
- using the electronic game card writing means,
- transmitting at least one second new value data in relation to the at least one other game console using the communication means, and displaying, on the display, at least one of the first data item, the second data item, the at least one first new value related to the at least one game related attribute of the electronic game card, at least one second new value related to the at least one game related attribute related to the second game console, and a game result

Appellants respectfully submit that claim 26 absolutely requires a game cartridge for each game console, otherwise the claimed steps would not be operable. Sawano does not teach or even suggest in the slightest the claimed steps, which require a game

cartridge in each game console. In fact, as discussed in the Brief and in more detail below, Sawano teaches away from the claimed invention. Sawano only teaches that master console has a cartridge and that slave consoles do not have a cartridge. Furthermore, as discussed in the Brief and below, Sawano only transmits a "transfer request," the Examiner admits is not a game result. For these reasons, the Section 102 rejection of claim 26 should be withdrawn.

Claims 17-18 and 21-23 are not anticipated by Sawano.

On page 5 of the Examiner's Answer, the Examiner argues that:

Appellant's arguments with respect to claims 17-18 and 21-23 have been considered but are not persuasive because they are not in commensurate scope with the claims. While the argument is made that Sawano discloses source code being transferred and appellant's invention relates to source code being executed, the claim language of claims 17-24 and 26 recites merely a game console with "a processor being configured for..." and does not recite the execution of any program, steps or code of any kind. Sawano discloses a game console with a processor that is configured for, and capable of, performing the steps recited in the claims as presented.

Appellants respectfully submit that Sawano does not disclose a game console with a processor that is configured for, and capable of, performing the steps recited in the claims. While claim 17 does not explicitly recite that source code is executed as pointed out by the Examiner, claim 17 specifically recites a configuration for "generating a game result". Appellants submit that "generating a game result" is a key difference between Sawano and the claimed invention.

The Examiner has argued that "generating a game result" is equivalent to (Figure 12A; S56, of Sawano using a transfer command to determine if the data is transferred and continuing a flow chart). Appellants respectfully submit that they are not the same for the following reasons. In the present invention, the result of transfer of data from one unit to another unit can be, for example, either yes or no. In programming language it is common knowledge to set a flag to 1 or 0 where 1 means Yes: all the

data was transferred (=Yes) or 0 which means No: some of the transferring of the data went wrong (=No). This means that the result of transferring data in data transfer is always digital. Transferring of data in the digital world is always exact and precise either the data bit was transferred or it was not.

Present claim 17 recites a configuration for "**reading a first data from an electronic data card**", "**receiving a second data from a second game console**" and "**generating a game result based on the first data and the second data**". These steps are not disclosed in Sawano.

"Generating a game result" according to common knowledge could be, for example, 103, 11, 45, 288262, 45298, 0, 89276...etc. A game result is a consequence of a game that has been played and the result is mainly related to how successfully the game participant was in playing the game. A game result is descriptive and could vary for example from a large number, big win, to, for example, negative numbers: a loss.

Generating a game result is not a direct consequence of a data transfer as described in Sawano. See paragraph 104 of Sawano, cited by the Examiner, which states "S52 serves as a transfer request or transfer request command" from a master portable game machine to a slave portable game machine. A transfer request is not a game result. The Examiner even admits that Sawano does not teach "generating a game result," as shown in the next full paragraph. For these reasons alone, the Section 102 rejection should be withdrawn.

On page 6 of the Examiner's Answer, the Examiner argues that:

Appellant's argument that generating a game result is patentably distinct and not disclosed by Sawano is not found to be persuasive. Appellant argues that a game result is more than a yes/no, 1/0 result as disclosed by Sawano. Applicant does admit however that a game result can be 0, amongst other results (Page 6, paragraph 5, line 5 of Appellant's Appeal brief). Sawano, by applicants admission, therefore discloses a game result from a sub-set of appellants game results. **While Sawano might not disclose generating a game result** that can fall in as broad a range as appellants invention, he does disclose a game result

within the range of appellant's claimed invention and therefore properly anticipates the claims. [Emphasis added.]

Sawano simply does not disclose generating a game result. The fact that a particular game result can be 0, does **not** mean that there is overlap between the claimed invention and Sawano. Sawano teaches a "transfer request" as discussed above. A "transfer request" is not a game result.

On page 6 of the Examiner's Answer, the Examiner argues that:

Appellant's argument that Sawano does not disclose a cartridge in each console is not in commensurate scope with the claims. Nowhere in claims 17-18 and 21-23 is there a limitation for more than one cartridge. Claim 17 recites, "reading a first data item from an electronic game card" and, "receiving a second data item from a second game console". Sawano discloses a game cartridge providing data from a first or master game console and data provided by a second game console, as cited in the previous rejections. Sawano therefore properly anticipates the claimed invention of claim 17 with regards to the amount of recited game cartridges required.

The claimed invention requires a game cartridge in game console, otherwise the claimed steps would not be operable. Appellants pointed out the actual teachings in Sawano (the "slave consoles" do not have game cartridges) to demonstrate that these slave consoles could not possibly be used to practice the claimed invention. Only the master game console of Sawano has a cartridge. Furthermore, the master console and cartridge of Sawano is set up very differently than the claimed game consoles, for the reasons of record and for the above reasons. For these reasons, withdrawal of the Section 102 rejection is respectfully requested.

Claim 24 is separately patentable.

On pages 6-7 of the Examiner's Answer, the Examiner argues that:

Appellant's arguments with respect to claim 24 are not found to be persuasive. Appellant asserts that no language from Sawano was cited to explicitly point out where the data contained on the game cartridge included a "game related attribute and at least one value associated thereto". Examiner cited paragraph 0059, explicitly the back-up of information, in paragraph number 3 on page 2 of the final office action, with regards to the type of data contained on the game cartridge. It is obvious to any one of ordinary skill in the art that back-up data of a game on a game cartridge, as cited by the examiner, contains game attributes, values and information pertinent to the progress of the game it is backing up. Again, appellant's argument that Sawano does not disclose a game cartridge in each game console is not in commensurate scope with the claims for the same reasons as discussed in the paragraph above.

Claim 24 recites "the electronic game card comprising a memory comprising changeable data, the changeable data comprising at least one **game related attribute and at least one, value associated thereto**; the electronic game card when inserted into the electronic game card receiving means, being configured for allowing reading of the at least one value related to the at least one game related attribute, using the electronic game card reading means; and receiving at least one new value, which new value is generated by the processor of the first game console and which is related to the at least one game related attribute."

The Examiner cites paragraph 59 of Sawano as disclosing the claimed steps. However, paragraph 59 of Sawano only discloses that "The game cartridge 40 in this example includes a ROM 74 (e.g., of a mask ROM) and a RAM 76 (e.g., an SRAM). The ROM 74 stores, for example, a game program or other application. RAM 76 is available for storing backup data and may be non-volatile (e.g., battery backed)." This disclosure in paragraph 59 of Sawano must be interpreted in light of the entire teaching of Sawano. As discussed above, Sawano only transfers source code data, not a "game related attribute." Thus, the "RAM 76" of Sawano cannot not anticipate the specifically

recited “changeable data comprising at least one **game related attribute and at least one, value associated thereto.**”

Furthermore, as discussed above, Sawano does not require a cartridge 40 in each console. Thus, Sawano cannot possibly teach that the game machine and cartridge 40 are configured such that “at least one game related attribute and at least one, value associated thereto” is present on the game card and is configured to receive “at least one new value... generated by the processor” of another game console. For these reasons and the reasons in the Brief, withdrawal of the the Section 102 rejection of claim 24 is respectfully requested.

Claims 19 and 20 are not obvious.

On page 8 of the Examiner’s Answer, the Examiner argues that:

Appellants arguments with regards to claims 19 and 20 are not persuasive since the examiner maintains that Sawano properly anticipated the claims that claim 19 and 20 depend from.

Sawano does not anticipate the claim 17 for the reasons provided above and in the Brief. Appellants submit that Sawano and the present invention are two completely different configurations: Sawano teaches how “to transfer source code” and not how it works when the source code is executed. In contrast, the present invention recites **how** the “source code is executed” as discussed above.

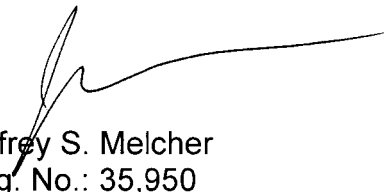
Itou does not provide the deficiencies of Sawano. Itou also does not teach how the source code is executed. Thus, the combination of Itou and Sawano only teaches how to “transfer source code,” which is very different from the presently claimed invention, which claims how the source code is executed. For these reasons and the reasons in the Brief, withdrawal of the Section 103 rejection is respectfully requested.

Conclusion

In view of the lack of anticipation and obviousness over the cited references discussed above, it is believed that this application clearly and patentably distinguishes over the cited references and is in proper condition for allowance. Accordingly, Appellants respectfully request that the Board allow claims 17-24 and 26 over the cited references.

Respectfully submitted,
Manelli Denison & Selter, PLLC

By



Jeffrey S. Melcher
Reg. No.: 35,950
Tel. No.: 202.261.1045
Fax. No.: 202.887.0336

Customer No. 20736